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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,521	02/08/2002	Lere Bao	PTZ-007	1273

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LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON, MA 02109

EXAMINER

DAVIS, MINH TAM B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 01/20/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,521

Applicant(s)

BAO ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 1-40 are pending and subjected to the following restriction requirement.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1-4 link the inventions of groups 1-6. Claim 37 links the inventions of groups 7-8. Claim 40 links the inventions of groups 9-10. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-4, 37. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

This application contains claims directed to the following patentably distinct inventions linked by claims 1-4, 37, 40:

Group 1. Claims 1-5, 7-16, 24-35, drawn to a method for facilitating diagnosis of prostate cancer, or prostate cancer metastasis, comprising detecting the protein level of Pin1, classified in class 435 , subclass 7.1.

Group 2. Claims 1-4, 7-8, 17-35, drawn to a method for facilitating diagnosis of prostate cancer, or prostate cancer metastasis, comprising detecting the mRNA level of Pin1, classified in class 435, subclass 6.

Group 3. Claims 3, 5, 7-16, drawn to a method for measuring the aggressiveness of prostate cancer, comprising detecting the protein level of Pin1, classified in class 435 , subclass 7.1.

Group 4. Claims 3, 7-8, 10, drawn to a method for measuring the aggressiveness of prostate cancer, comprising detecting the level of Pin1, classified in class 435, subclass 6.

Group 5. Claims 6, 36, drawn to a method for detecting a response to prostate cancer therapy, comprising detecting the protein level of Pin1, classified in class 435, subclass 7.1.

Group 6. Claims 6, 36, drawn to a method for detecting a response to prostate cancer therapy, comprising detecting the mRNA level of Pin1, classified in class 435, subclass 7.1.

Group 7. Claims 37-39, drawn to a method for detecting risk of developing metastatic prostate cancer, comprising detecting the protein level of Pin1, classified in class 435, subclass 7.1.

Group 8. Claims 37-39, drawn to a method for detecting risk of developing metastatic prostate cancer, comprising detecting the mRNA level of Pin1, classified in class 435, subclass 6.

Group 9. Claim 40, drawn to a method for detecting risk of development PSA failure, comprising detecting the protein level of Pin1, classified in class 435, subclass 7.1.

Group 10. Claim 40, drawn to a method for detecting risk of development PSA failure, comprising detecting the mRNA level of Pin1, classified in class 435, subclass 6.

The inventions are distinct, each from each other because of the following reasons:

The methods of groups 1-10 are distinct from each other because they differ at least in objectives, method steps, reagents and/or dosages, and/or schedules used, response variables and criteria for success.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, and further, because the searches for the groups are not co-extensive, and therefore, it would be a serious burden for the Examiner to examine all the groups and species together, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted even though the requirement could be traversed.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if

one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

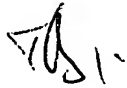
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

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MINH TAM DAVIS

Handwritten signature or initials, possibly "TDS" or similar, in black ink.

Patent Examiner

November 26, 2003